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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/232,488	01/15/1999	DONNA E. PRUNKARD	PPL-1REISSUE	1781

7590

07/10/2006

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EXAMINER
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CROUCH, DEBORAH

ART UNIT	PAPER NUMBER
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1632

DATE MAILED: 07/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/232,488

Applicant(s)

PRUNKARD ET AL.

Examiner

Deborah Crouch, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-13 and 16-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-13 and 16-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 January 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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Applicant's arguments filed April 7, 2006 have been fully considered but they are not persuasive. The amendment has been entered. Claims 1, 2, 5-13 and 16-34 are pending. Applicant is reminded that all claims have to be labeled with sequence identifiers. For example, claim 2 does not have an identifier. It appears that claim 2 is an original claims, thus, the identifier (original) should have been inserted prior to the beginning of the claims.

37 § CFR 1.121(c) states:

Claims. Amendments to a claim must be made by rewriting the entire claim with all changes (e.g., additions and deletions) as indicated in this subsection, except when the claim is being canceled. Each amendment document that includes a change to an existing claim, cancellation of an existing claim or addition of a new claim, must include a complete listing of all claims ever presented, including the text of all pending and withdrawn claims, in the application. The claim listing, including the text of the claims, in the amendment document will serve to replace all prior versions of the claims, in the application. In the claim listing, the status of every claim must be indicated after its claim number by using one of the following identifiers in a parenthetical expression: (Original), (Currently amended), (Canceled), (Withdrawn), (Previously presented), (New), and (Not entered).

The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following:

The oath filed January 15, 1999 does not state, "all errors arose without deceptive intent on the part of applicants." In particular, there is no without deceptive intent statement regarding the amendment to "heterologous" genomic segments in claims 30. A substitute oath is further required because of the amendment "linked on a single vector" is not contained in the original reissue oath (37 § CFR 1.175(b)(1)).

Claims 1, 2, 5-13, 16-34 are rejected as being based upon a defective reissue oath under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the oath is set forth in the discussion above in this Office action.

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The language regarding declarants having "reviewed" the application is found as applicant stated in paragraph 3. However, "heterologous" is not seen in paragraphs 7-9, as referred to in paragraph 10.

Claims 18-22 and 26-33 remain rejected under 35 U.S.C. 251 and 37 CFR 1.658 as corresponding to the count lost in Interference No. 104,242. Applicants did not file a request for reconsideration of this decision within one month after the date of the decision under 37 CFR 1.658(b), or file an appeal to the Court of Appeals for the Federal Circuit or civil action in a United States district court under 35 U.S.C. 141 or 146 respectively. The judgment of the Board of Patent Appeals and Interferences stands, see 37 CFR 1.658(a). It is noted according to 37 CFR 1.658(c) that this judgment settles all issues which were raised and decided in the interference. A second interference is not permissible to decide the same issues. See also MPEP 2358.

With regard to claims 18-20, applicant argues the amendment to the claims that the three genomic segments are linked on a single vector overcomes this rejection, as the new limitation is not part of the count in I104,242. This argument is not persuasive as the single vector limitation is not in claims 18-20.

With regard to claims 21, 22 and 26-33, the mammals claimed therein correspond to the count in spite of the limitation that the genomic DNA segments are linked in a single vector. This limitation is product by process language and does not distinguish from the mammals of the count.

Claims 18-22 and 26-33 are further objected to under 37 CFR 1.633 on the grounds of estoppel. As noted above, the Judgment in Interference No. 104,242 determined that the parent, U.S. Patent 5,639,940, was not entitled to a patent containing claims 1-33 of, which

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correspond to the count. Present claims 18-22 and 26-33 also correspond to the count and thus are prevented from prosecution on the grounds of estoppel.

Claims 18-22 and 26-33 are rejected under 35 USC 103 as unpatentable was made by the Board of Patent Appeals and Interferences in Interference proceeding 104,242 and was affirmed on appeal to the CAFC (I-104,242, paper 110). As the pending claims are the same as, or of similar scope, to those for which this rejection was affirmed, the CAFC decision stands as *res judicata* on these claims. A Board of Patent Appeals and Interferences decision in an application has *res judicata* effect and is the "law of the case" and is thus controlling in that application and any subsequent, related application. Therefore, a submission containing arguments without either an amendment of the rejected claims or the submission of a showing of facts will not be effective to remove such rejection. See MPEP § 706.03(w).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah Crouch, Ph.D. whose telephone number is 571-272-0727. The examiner can normally be reached on M-Fri, 7:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla, Ph.D. can be reached on 571-272-0735. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Deborah Crouch, Ph.D.  
Primary Examiner  
Art Unit 1632

June 27, 2006